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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,922	12/19/2000	Dan Vassilovski	990092	4872
23696	7590	06/02/2005	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/739,922	VASSILOVSKI, DAN	
	Examiner Lisa Hashem	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-55 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

FINAL DETAILED ACTION

1. The evidence to show common ownership between the instant application and U.S. Patent No. 6,477,150 by Maggenti et al filed January 4, 2005 is ineffective to overcome the rejection of claim(s) 1-55 based upon the 35 U.S.C. 103(a) rejection under Maggenti et al in view of Varziri et al, as set forth in the last Office action because: no affidavit or declaration was submitted to show that the present application and Maggenti et al are commonly owned as set forth in the MPEP. See MPEP § 1.130 or § 1.131. For further information, please see the instructions listed under the 35 U.S.C. 103(a) rejection below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,150 by Maggenti et al, hereinafter Maggenti, in view of U.S. Patent No. 6,671,272 by Vaziri et al, hereinafter Vaziri.

4. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Maggenti discloses a communication device (CD) in a CDMA system (Figure 2, 202; column 9, lines 61-64; column 10, lines 4-7) operable in at least two states, voice or data (column 6, lines 31-34), a method of inherently transitioning between a call in a first state and a second state or inherently receiving a request for change of state (column 4, lines 9-12; column 9, lines 58-60; column 10, lines 1-4; column 7, lines 48-57), each state inherently having a distinct, associated number (column 10, lines 20-24: a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000), each number having a prefix portion (e.g. 619) and a suffix portion (e.g. 972-6921), the call having at least one called party (Figure 2, 204) and a calling party (as shown in Figure 2: 202), the method comprising: requesting a change of state or change of service option (column 9, lines 53-54); inherently, establishing a new call using the number corresponding to the second state (column 14, lines 32-35); and inherently

sending the number (including at least the suffix portion) corresponding to the second state to the calling party (column 7, lines 55-57).

Maggenti does not disclose: sending at least the suffix portion of the number corresponding to the second state to the calling party; comparing the number corresponding to the first state with the number corresponding to the second state; and appending the prefix portion of the number corresponding of the first state with the suffix portion of the number corresponding to the second state.

Vaziri discloses an Internet telephony communication system comprising: two users, each having an Internet switch box connected to the telephone set. When they want to have an Internet telephony conversation, they signal their Internet switch boxes, by pressing either buttons on the switch boxes on the telephone keypads, to switch to Internet telephony. The switch boxes disconnect the PSTN call and connect to their ISPs. Once the switch boxes are on the Internet, they contact each other through a server which supplies Internet protocol (IP) addresses of switch boxes, and the users continue their conversation by Internet telephony (see Abstract).

Vaziri further discloses requesting a change of state (column 13, lines 39-45); sending at least the suffix portion of the number corresponding to the second state to the calling party (see Figure 6, 610); comparing the number corresponding to the first state with the number corresponding to the second state; and appending the prefix portion of the number corresponding of the first state with the suffix portion of the number corresponding to the second state (column 7, lines 25-36; column 8, lines 9-24; column 13, lines 4-38; column 15, lines 10-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Maggenti to include prefix and suffix portions of numbers as taught by Vaziri to transition between a first state and a second state. One of ordinary skill in the art would have been lead to make such a modification since the first and second states have associated numbers that are distinct and the alternate numbers can be found to connect both parties in the second state.

Regarding claim 2, the method as set forth in claim 1 mentioned above, wherein Vaziri further discloses comprising storing the number corresponding to the first state in memory associated with the calling party (column 12, lines 57-64).

Regarding claim 3, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses comprising establishing a call in the first state prior to requesting a change of state (column 7, lines 50-57; column 9, lines 58-60).

Regarding claim 4, the method as set forth in claim 1 mentioned above, wherein Vaziri further discloses the prefix portion (e.g. 202) comprises regional codes and the suffix portion (e.g. 555-0102) comprises the telephone number (column 13, lines 20-31).

Regarding claims 5-6, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is a clear state and the second state is a secure state or the first state is a secure state and the second state is a clear state (column 5, lines 18-20).

Regarding claims 7-8, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is a voice state and the second state is a data state or the first state is a data state and the second state is a voice state (column 4, lines 6-12; column 6, lines 31-32).

Regarding claim 9, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the first state is, inherently, a first phone number and the second state is, inherently, a second phone number (column 10, lines 20-24; a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000).

Regarding claim 10, the method as set forth in claim 1 mentioned above, wherein Maggenti further discloses the calling party (Figure 2, 202) and the at least one called party (Figure 2, 204) are on a wireless call (column 9, lines 22-25).

Regarding claims 11-20, 21-30, and 31-40, please see the rejection of the method in claims 1-10 above to reject the method in claims 11-20, 21-30, 31-40, respectively.

Regarding claim 41, Maggenti discloses an apparatus (Figure 2, 218) configured to transition between a first state and a second state during a call (column 3, lines 63-65; column 4, lines 9-12), each state inherently having a distinct, associated number (column 10, lines 20-24; a first state which is a voice call can be made by using a dial number: 619-972-6921; and a second state which includes a data service option (e.g. fax) has an associated number: 619-972-9000), each number having a prefix portion (e.g. 619) and a suffix portion (e.g. 972-6921), the call having at least one called party (Figure 2, 204) and a calling party (as shown in Figure 2: 202), the apparatus comprising: inherently receiving a request of a change of state (column 7, lines 41-57); and establishing a new call using the number corresponding to the second state (column 6, line 62 – column 7, line 7).

Maggenti does not disclose: a receiver inherently configured to receive a request of a change of state; a comparer configured to compare the number corresponding to the first state

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with the number corresponding to the second state; a grouper coupled to the comparer configured to append the prefix portion of the number corresponding of the first state with the suffix portion of the number corresponding to the second state; and an establisher configured to establish a new call using the number corresponding to the second state.

Vaziri discloses an Internet telephony communication system comprising: two users, each having an Internet switch box connected to the telephone set. When they want to have an Internet telephony conversation, they signal their Internet switch boxes (ISB), by pressing either buttons on the switch boxes on the telephone keypads, to switch to Internet telephony. The switch boxes disconnect the PSTN call and connect to their ISPs. Once the switch boxes are on the Internet, they contact each other through a server which supplies Internet protocol (IP) addresses of switch boxes, and the users continue their conversation by Internet telephony (see Abstract).

Vaziri further discloses a receiver configured to receive a request of a change of state (column 7, lines 9-24); a comparer configured to compare the number corresponding to the first state with the number corresponding to the second state (column 8, lines 9-24); and a grouper coupled to the comparer configured to append the prefix portion of the number corresponding of the first state with the suffix portion of the number corresponding to the second state (column 13, lines 4-38; column 9, lines 5-17; column 10, lines 18-41), wherein the ISB includes components to process all the above operations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Maggenti to include components configured to perform include prefix and suffix portions of numbers and as taught by Vaziri to transition between a first state

and a second state. One of ordinary skill in the art would have been lead to make such a modification since the first and second states have associated numbers that are distinct and the alternate numbers can be found to connect both parties in the second state. The ISB is configured to perform these operations in order to ensure a change from a first state to a second state.

Regarding claim 42, the apparatus set forth in claim 41 mentioned above, wherein Vaziri further discloses the receiver is further configured to receive the number corresponding to a state from the calling party (see Figure 6, 610).

Regarding claim 43, the apparatus set forth in claim 41 mentioned above, wherein Vaziri further discloses the ISB configured to store the number corresponding to the first state in memory associated with the calling party (column 12, lines 57-64).

Regarding claim 44, the apparatus set forth in claim 41 mentioned above, wherein Vaziri further discloses the ISB is configured to establish a call in the first state or voice state, prior to any change of state (column 4, lines 32-37).

Regarding claims 45-51, please see the rejection of the method in claims 4-10 above to reject the method in claims 42-51, respectively.

Regarding claim 52, please see the rejection of the method in claims 11 and 13 above to reject the method in claim 52.

Regarding claim 53, please see the rejection of the method in claims 11-13 above to reject the method in claim 53.

Regarding claim 54, please see the rejection of the method in claims 41-43 above to reject the method in claim 54.

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Regarding claim 55, please see the rejection of the method in claims 41-44 above to reject the method in claim 55.

Response to Arguments

5. Applicant's arguments filed 1-04-2005 have been fully considered but they are not persuasive. The 35 U.S.C. 103(a) rejection was not overcome by Applicant's arguments. All proper affidavits or declarations were not submitted.
6. Accordingly, this action is **FINAL**.

Conclusion

5. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

LH

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May 28, 2005

Ovidio Escalante